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VIA AIRMAIL

TANI & ABE

No. 6-20, AKASAKA 2-CHOME MINATO-KU, TOKYO 107-0052 JAPAN http://www.taniabe.co.jp TELEPHONE 81-3-3589-1201 FACSIMILE PATENTS: 81-3-5561-7522 (G4) 81-3-3586-4828 (G3) TRADEMARK:

81-3-3589-1257 (G3) 81-3-5561-7580 (G4) E-MAIL PATENTS To Overseas: pat_intl@taniabe.co.jp PATENTS From Overseas:

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RECEIVED APR 28 2006

LEE & HAYES, PLLC

April 25, 2006

Mr. Steven R. Sponseller Lee & Hayes PLLC 421 West Riverside Avenue Suite 500, Spokane Washington 99201 U. S. A.

Re: Japanese Patent Application No. 2002-048648

Your Ref: MS1-770JP Our Ref: PH131254

Title: Method and Apparatus for Creating and Playing

Soundtracks in a Gaming System
In the name of: MICROSOFT CORPORATION

Dear Mr. Sponseller:

This is to inform you that we received a first Official Notice of Rejection regarding the captioned application from the Japan Patent Office. The reasons are as stated in the Official Notice.

Enclosed please find

- (*) the Official Notice; and
- (*) the cited references.

The due date for responding to this rejection is <u>June 28, 2006</u>, although a three-month extension of term can be obtained, if necessary.

We will provide you with our comments in this regard as soon as we complete our review.

Kindly acknowledge receipt of this letter by return facsimile.

Very truly yours,

Tani & Abe

:jt

Encls.

(Translation)

OFFICIAL NOTICE OF REJECTION mailed on March 28, 2006 Japanese Patent Application No. 2002-048648

Reasons

Reason 1: The present application is deficient in the points below. Therefore, the present application fails to conform to the requirements prescribed under Section 37 of the Japanese Patent Law.

Reason 2: The recitations of claims of the present application are deficient in the points below. Therefore, the present application fails to conform to the requirements prescribed under Section 36, Paragraph 6, Item 2 of the Japanese Patent Law.

Reason 3: The present invention(s) as claimed in claim(s) set forth below would have been obvious to one having ordinary skill in the art, to which the inventions(s) pertain(s), prior to the filling date of the present application, on the basis of an invention(s) described in the publication(s) set forth below as distributed in Japan or foreign countries or an invention(s) made available to the public through the telecommunication line prior to the filling date of the present application. Therefore, the present invention(s) is(are) unpatentable under the provision of Section 29, Paragraph 2 of the Japanese Patent Law.

Remarks (See a Reference List given below)

A. Reason 1

The substantial part of the inventions of claim 1 (and claims 2 to 13 which depend on claim 1 and claims 39 to 41) comprises a memory; a processor coupled to the memory; and a console application stored in the memory and executable on the processor, the console application configured to create a soundtrack containing a plurality of audio tracks. However, the substantial parts of the inventions of claim 14, 21, 28, 34, 42, claims 15 to 20 which depend on claim 14, claims 22 to 27

which depend on claim 21, claims 29 to 33 which depend on claim 28, claims 35 to 38 which depend on claim 34, and claims 43 to 44 which depend on claim 42 differ from this substantial part of the inventions 1 to 13, and 39 to 41. In view of the above, the inventions of claims 14 to 38, and 42 to 44 fail to satisfy any of the requirements prescribed under Section 37, Items of the Japanese Patent Law.

Since the present application violates the provision of Section 37 of the Japanese Patent Law, the inventions of the claims other than claims 1 to 13, and 39 to 41 have not examined as to the requirements other than those of Section 37 of the Japanese Patent Law.

- B. Reason 2
- Present claim 1 recites "a game console, comprising: a memory;
- a processor coupled to the memory; and

a console application stored in the memory and executable on the processor, the console application configured to create a soundtrack containing a plurality of audio tracks". In this recitation, the claimed invention per se is directed to "the game console" which is categorized as a product invention. However, the claimed invention merely comprises "the memory", "the processor", and "the console application configured to create a soundtrack containing a plurality of audio tracks" as the constituent elements of the product invention. Thus, it is unclear technically what of the product invention is defined by the recitation "configured to create a soundtrack containing a plurality of audio tracks".

Claims 2 to 13 add mere functional expressions or expressions of mere wishful thinking. Therefore, it is unclear what feature of "the game console" which is the product invention is defined and how it is defined.

(The same rejection applies for claims 14 to 20).

(2) Present claim 39 recites "a user interface for a game console, comprising:

a music collection menu configured to identify soundtracks that are currently available to play on the game console; and

a soundtrack creation menu accessible from the music collection menu to create a soundtrack from one or more audio

tracks". However, from this recitation, it is unclear whether or not "the user interface" is categorized as a product invention. The content of the claimed invention is recited merely as "comprising ... a ... menu; and a ... menu". Thus, the category of the claimed invention is unclear. (Is it a method invention or a product invention?). Further, the feature of the claimed invention is unclear, because claim 39 merely recites "comprising a ... menu" as the feature of the claimed invention.

The same rejection applies for claims 40 and 41.

Thus, the inventions of claims 1 to 13, and 39 to 41 are unclear.

Incidentally, according to "the Japanese Patent Office, the Examination Guidelines, Part VII Examination Guidelines for Inventions in Specific Fields, Chapter 1 Computer Software-Related Inventions", such inventions are defined as:

"'A computer-readable storage medium having a program recorded thereon' or 'A computer-readable storage medium having structured data recorded thereon' where processing performed by a computer is specified by the data structure recorded thereon can be recited as 'a product invention' in the claims, and "'a program' which specifies a multiple of functions performed by a computer can be recited as 'an invention of a product' in the claims."

However, present claims 27, 33, and 38 are formulated as quoting method inventions. Therefore, the categories of the claimed inventions are unclear, and the recitations of the claimed inventions are unclear as well.

- C. Reason 3
- 1. References 1 and 2

References 1 and 2 below, which are publications as distributed in Japan, prior to the filing date of the present application, respectively disclose as follows.

(1) Reference 1: "ASCII, the March issue, 2001 (The Anatomy of XBOX which is Inaccessible to the Readers of Game Magazines: The Latest Information of the War for TV Viewers at the Present Stage in 21st century", ASCII Corporation., March 1, 2001, Vol. 25, No. 3, pages 249 to 264

On page 253, at right column, reference 1 discloses "equipped with a network function and an HDD as standard".

On page 254, at middle column, reference 1 discloses as follow:

"Another interesting description is found in an illustration of a general outline of hardware of an Xbox. 'An MCPX' connected to 'an XGPU' is a chip into which a sound function (an APU) and an HDD/DVD interface, etc. are integrated. A bus connecting the MCPX with the XGPU is a full-duplex bus, each line of which bas has a bandwidth of 400MB/second. The full-duplex bus is capable of transmitting data from the MCPX to the XGPU, even while transmitting data from the XGPU to the MCPX. For example, even while the APU is receiving large volume data for playback of sound, a read operation from an HDD or an Ethernet to a memory can be carried out smoothly." (see also Fig. 1 on page 254 and its relevant description)

On page 256, from middle column to right column, reference 1 discloses as follows:

"The Possibilities of the HDD - Storing Changes of the World: Questioner: I hear that the developers highly appreciate the fact that the Xbox has a built-in HDD as standard, from among the specifications of the Xbox. Can the developers make full use of the element such as the HDD which has not existed in a game machine so far?

Yoshioka: All the same, the HDD is the most interesting feature of the Xbox. CPU performance and graphical performance of the Xbox are extremely high. The sound of the Xbox will become strong as well."

(2) Reference 2: Japanese Patent Application Laid-open No. 2000-228051

Paragraphs [0011] to [0012] of reference 2 disclose as follows:

"Fig. 1 is a block diagram which illustrates a configuration of a game device for carrying out the present invention in an embodiment. The game device comprises a main body 1, an input device 2, a CD-ROM 3, and a display 4. The main body 1 is provided with a CPU 100, an ROM 101, an RAM 102, an I/O110, and a drive 120. The input device 2 is provided with a movement key 201 and a selection key 202, and connected to the main body 1 by means of a cable. The CD-ROM 3 stores a game

program and can be freely engaged with and disengaged from the drive 120. The display 4 is a TV receiver, and connected to the main body by means of an RF cable. "When a user sets the CD-ROM 3 in the drive 120 of the main body 1 and presses the selection key 202, the main body 1 is powered on. This enables the CPU 100 to read and carry out a boot program inside the ROM 101, and consequently to carry out a game program recorded in the CD-ROM 3. The game program is carried out in an interactive style with the user, and the user carries out input by means the input device 2 while viewing the display 4. This type of game device is well known also as hardware. It can be safely said that this type of game device is considered as one of devices which are abundantly currently on the market.

Paragraph [0013] of reference 2 discloses as follows: "Fig. 2 is an A-A expanded sectional view of Fig. 3. The CD-ROM 3 consists of a transparent resin layer 301 made of polycarbonate, a reflexive layer 302 made of aluminum, a protective layer 303, and a label 304. In other words, the CD-ROM 303 has a structure wherein the label 304 is pasted on a protective layer of a conventional CD-ROM. Audio information etc. including a game program is recorded on spiral tracks wherein lands and pits are aligned on the reflective layer 302. The tracks are divided into lead-in, data tracks, a plurality of audio tracks, and lead-out, like a conventional, general CD-ROM for a game. In the case of the embodiment, the data tracks are further divided into three partitions (referred to as a first partition, a second partition, and a third partition). It is a publicly-known technique that a CD-ROM has a multi-partition structure. Here, we have no intention to bring the subject of this feature, in particular. Further, publicly-known techniques such as a TOB and a partition map will not be mentioned here. Incidentally, a system program, a game program, a program which is necessary for carrying out a game, and data, etc. which will be discussed below are written on the third partition."

Paragraph [0003] of reference 2 discloses that "a CD-ROM... and various other types of media such as DVD, DVD-R, etc. which have the same characteristics as a CD-ROMare present and expected to increase from now on".

Comparison and Contrast

In comparison of the present inventions of claims 1 to

13, and 39 to 41 with the inventions of references 1 and 2 above, the features of the present inventions of claims 1 to 13, and 39 to 41 are unclear, as stated in Reason 2 above. Both of references 1 and 2 disclose a game console which comprises a memory, a processor, a CD/DVD, and its driver, as a built-in configuration. In particular, reference 2 discloses the feature(s) relating to a plurality of audio tracks. In view of the above, the same advantageous result as the present inventions of claims 1 to 13, and 39 to 41 is produced by the inventions of references 1 and 2. Thus, one skilled in the art could have easily arrived at the present inventions of references 1 to 13, and 39 to 41, based upon the inventions of references 1 and 2.

With respect to the invention(s) of claims other than claims indicated in this Official Notice of Rejection, no ground for rejection has been found so far. If any ground for rejection is newly found, the rejection will be notified.

In view of the above, one skilled in the art could have easily arrived at the present inventions of claims 1 to 13, and 39 to 41, based upon the inventions of references 1 and 2. Thus, the present inventions of claims 1 to 13, and 39 to 41 are unpatentable under the provision of Section 29, Paragraph 2 of the Japanese Patent Law.

Reference List

Reference 1: "ASCII, the March issue, 2001 (The Anatomy of XBOX which is Inaccessible to the Readers of Game Magazines: The Latest Information of the War for TV Viewers at the Present Stage in 21st century", ASCII Corporation., March 1, 2001, Vol. 25, No. 3, pages 249 to 264

Reference 2: Japanese Patent Application Laid-open No. 2000-228051

Record of Search Result of Prior Art Literature

Technical Field Searched IPC

A63F 13/00 to 13/12

Prior Art Literature

This record of search result of prior art literature does not constitute reason for rejection.

拒絶理由通知書

特許出願の番号

特願2002-048648

起案日

平成18年 3月24日

特許庁審査官

松川 直樹 8804 2 T 0 0

特許出願人代理人

谷 義一(外 1名) 様

適用条文

第29条第2項、第36条、第37条

この出願は、次の理由によって拒絶をすべきものである。これについて意見が あれば、この通知書の発送の日から3か月以内に意見書を提出して下さい。

理 由

理由1:この出願は下記の点で特許法第37条に規定する要件を満たしていない

理由2:この出願は、特許請求の範囲の記載が下記の点で、特許法第36条第6項第2号に規定する要件を満たしていない。

理由3:この出願の下記の請求項に係る発明は、その出願前日本国内又は外国に おいて頒布された下記の刊行物に記載された発明又は電気通信回線を通じて公衆 に利用可能となった発明に基いて、その出願前にその発明の属する技術の分野に おける通常の知識を有する者が容易に発明をすることができたものであるから、 特許法第29条第2項の規定により特許を受けることができない。

記 (引用文献等については引用文献等一覧参照)

A. 理由1

この出願は、特許法第37条の規定に違反しているので、請求項 $1\sim13$ 、3 $9\sim41$ 以外の請求項に係る発明は同法第37条以外の要件についての審査を行

っていない。 B. 理由2

(1) 本願請求項1における「メモリと、前記メモリに連結されたプロセッサと、前記メモリに格納され、かつ前記プロセッサ上で実行可能であり、複数のオーディオトラックを含むサウンドトラックを作成するように構成されているコンソールアプリケーションとを含むことを特徴とするゲームコンソール。」との記載では、発明自体は「ゲームコンソール」であって、物の発明であるが、物の発明としての構成は「メモリ」、「プロセッサ」、「複数のオーディオトラックを含むサウンドトラックを作成するように構成されているコンソールアプリケーション」とでしかなく、「複数のオーディオトラックを含むサウンドトラックを作成するように構成されている」とは技術的に物の発明の何を規定する記載であるのか不明である。

請求項 $2\sim13$ も、作用的・願望的な記載を付加するのみで、物の発明である「ゲームコンソール」の何をどのように定義するのか不明確である。 (請求項 $14\sim20$ も同様である)

(2) 本願請求項39における「ゲームコンソール用のユーザインターフェイスであって、

ゲームコンソール上で再生するために現在使用可能であるサウンドトラックを識別するように構成された音楽コレクションメニューと。

あるサウンドトラックを1つまたは複数のオーディオトラックから作成するために、前記音楽コレクションメニューからアクセス可能なサウンドトラック作成メニューとを含むことを特徴とするユーザインターフェイス。」との記載では、「ユーザインターフェイス」が物の発明であるのか否か不明であるが、その内容が「・・メニューと、・・メニューを含む」と記載されているだけで、発明の属するカテゴリー(方法?、物?)が不明であり、また、その発明の構成が「メニューを含む」だけであって不明である。

請求項40、41も同様である。

よって、請求項1~13、39~41に係る発明は明確でない。

なお、『特許庁 審査基準 第VII部 特定技術分野の審査基準 第1章 コンピュータ・ソフトウエア関連発明』には、『プログラムを記録したコンピュータ読み取り可能な記録媒体、又は記録されたデータの構造によりコンピュータ読み取り可能な記録媒体」は、「構造を有するデータを記録したコンピュータ読み取り可能な記録媒体」は、「物の発明」として請求項に記載することができる。」ないし『コンピュータが果たす複数の機能を特定する「プログラム」は、「物の発明」として請求項に記載することができる。』と規定しているが、本願請求項27、33、38は方法発明を引用する形式として記載されていて発明の属する

カテゴリーが不明であり、また、その記載も不明確である。

さらに、なお、請求項14はその記載からみて独立請求項であるが「前記メモリ」の前に「メモリ」が記載されていない。

C. 理由3

1. 各引用文献

本願特許出願前に日本国内において、頒布された刊行物である下記各引用文献にはそれぞれ下記の点が記載されている。

(1) 引用文献1 「ASCII 2001年3月号(ゲーム雑誌じゃ読めない XBOX解剖 21世紀お茶の間戦争の現段階最新情報)」株式会社アスキー2001年3月1日 第25巻 第3号 p. 249~264

引用文献1の第253頁右欄には「ネットワーク機能とHDDを標準搭載する」と記載され、

第254頁中欄には「Xboxのハードウェア概要図には、もう1つ面白い記述があった。XGPUにつながっている「MCPX」は、サウンド機能(APU)やHDD/DVDインターフェイスなどを集積したチップである。このMCPXとXGPUを結ぶパスは、それぞれが400MB/秒のパンド幅を持つ全二重のパスだというのだ。全二重のパスならば、XGPUからMCPXと送っている最中でも、MCPXからXGPUにデータを送れる。たとえばAPUがサウンド再生のために大量のデータを受信している最中でも、MD0年E1 トeE1 に E2 から E3 に記載され、(第254頁の図1 およびその説明文も参照)

第256頁中〜右欄には「HDDがもたらす可能性 世界の変化を保存する」として、「Xboxの仕様の中で、HDDを標準で内蔵という点がデベロッパから高評価を得ていたと聞きますが、今までゲーム機にはなかったHDDという要素を、デベロッパはうまく活用できているのでしょうか。

吉岡:やはりXboxの1番面白いフイーチヤーですからね。CPU性能やグラフィック能力は非常に高いですし、サウンドも強力なものになるでしょう。」と記載されている。

(2) 引用文献 2 特開 2 0 0 0 - 2 2 8 0 5 1 号公報

したがって、本願請求項 $1\sim13$ 、 $39\sim41$ に記載された発明は、当業者が引用文献1および2に記載された発明から容易に想到することができたものであり、特許法第29条第2項の規定により特許を受けることができない。

引用文献等一覧

1. 引用文献 1 「ASCII 2001年3月号(ゲーム雑誌じゃ読めない XBOX解剖 21世紀お茶の間戦争の現段階最新情報)」株式会社アスキー2001年3月1日 第25巻 第3号 p. 249~264 2. 引用文献 2 特開 2000-228051号公報

この拒絶理由通知書に対する問い合わせ先

特許審査第1部電子ゲーム

TEL 03-3581-1101 内線3266

先行技術文献調査結果の記録

- 調査した分野 IPC A63F13/00-13/12
- ・先行技術文献

この先行技術文献調査結果の記録は、拒絶理由を構成するものではない。

平成14年9月1日から文献公知発明情報の開示制度が導入されました。今後の出願については、明細書の従来技術の欄に文献公知発明情報(平成14年9月1日施行 特許法第36条第4項第2号 参照)を記載して下さい。